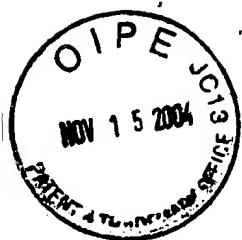<u>PATENT APPLICATION</u>

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November 12, 2004

Vicki L. Gilbert

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark D. Braxton	Group Art Unit 2611
ON-DEMAND METHOD AND SYSTEM FOR ENTERTAINING A USER	Examiner Joseph G. Ustaris
Serial No. 09/745,585	Filed December 21, 2000

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Commissioner of Patents and Trademarks
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

BRIEF FOR APPELLANT GENERAL MOTORS

Applicants are filing this Brief to support the Appeal of claim 3, which was finally rejected in the Office Action dated July 14, 2004. Please charge the fee required by this Brief to Deposit Account No. 07-0960.

TABLE OF CONTENTS

I. REAL PARTY IN INTEREST

In this appeal, the real party in interest is the assignee, Vauxhall Motors Limited, wholly owned subsidiary of General Motors Corporation.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF CLAIMS

Claim 3 is finally rejected and is on appeal.

Claims 1, 2 and 4-13 are cancelled by amendment dated May 12, 2004.

IV. STATUS OF AMENDMENTS

Vauxhall Motors has filed no amendments since the Final Rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 3 recites an on-demand method using an entertainment device that can provide entertainment to a user while also, as a background function not apparent to the user, monitoring and storing selected movies from remotely broadcast movie data. The method comprises the steps of: providing a conventional entertainment to the user (page 6, line 20 – page 7, line 4; fig. 3, references 64 and 66); monitoring a remote broadcast of for-demand movie data (page 7, lines 8-14; fig. 4, reference 82); receiving the for-demand movie data (page 7, lines 15-16; fig. 4, reference 84); storing the received for-demand movie data (page 7, lines 16-18; fig. 4, reference 86); providing the operator with a selection of choices corresponding to stored for-demand movie data (page 7, lines 18-22; fig. 4, reference 88);

receiving a user input designating an entertainment choice representing one of the choices corresponding to stored for-demand movie data (page 7, lines 22-23; fig. 4, reference 90); using the stored for-demand movie data corresponding to the designated entertainment choice to provide entertainment to the user, wherein the steps of monitoring the remote broadcast of for-demand movie data is carried out as a background function not apparent to the user (page 7, lines 23-24; fig. 4, reference 92).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claim 3 stands rejected under 35 U.S.C. 103(a) as unpatentable over Russo (US6025868) and Blackketter et al (US20030204854).

VIII. ARGUMENT

Russo discloses a system for stored program pay-per-play. The system has "automatic recording of one or more selections based ... upon viewer preferences ... for subsequent replay,"[1] which can be pay-per-view.[2] Russo does not disclose a system that can monitor and store remote broadcasts of movie data as a background function not apparent to the user. Blackketter discloses "communicating scripts in a data service channel of a video signal"[3] useful "for enhancing an information resource, such as a Web page, simultaneously residing in memory on a number of remote receivers."[4] Blackketter also does not disclose monitoring a remote broadcast of movie data as a background function not apparent to the user. Thus Russo and Blackketter, even when combined, do not disclose Applicants' claim 3.

Vauxhall Motors begins this Argument at the point from which all obviousness determinations must be made.

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[1] Col. 9, line 66 – col. 10, line 3.
[2] Abstract.
[3] Blackketter, title.
[4] Blackketter, p. 2, par. 0017.

A.   THE SCOPE AND CONTENT OF THE PRIOR ART

1.   The Reference Russo

Russo discloses a system for stored program pay-per-play. The system has "automatic recording of one or more selections based ... upon viewer preferences ... for subsequent replay"[5] which can be pay-per-view.[6] Russo does not disclose a system that can monitor broadcasts of for-demand movie data as a background function not apparent to the user.

2.   The reference Blackketter

Blackketter discloses communicating scripts in a data service channel of a video signal.[7] The system can "monitor the data service channel of the signal for triggers that are directed to the information resources resident on the receiver. Upon receipt of such a script trigger, the receiver executes the script contained within the trigger to alter the information resource and/or displayed video defined by the resource."[8] Information resources are typically "web pages".[9] Blackketter does not disclose an example where the information resource is replaced by for-demand movie data; it does not monitor broadcasts of for-demand movie data as a background function not apparent to the user.

B.   THE INVENTION OVER RUSSO AND BLACKKETTER

Claim 3 requires (i) *providing a conventional entertainment to the user,* (ii) *monitoring a remote broadcast of for-demand movie data ...(iii) storing the received for-demand movie data; ...*and *(iv) using the stored for-demand movie data corresponding to the designated entertainment choice to provide entertainment to the user, wherein the steps of*

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[5] Col. 9, line 66 – col. 10, line 3.
[6] Abstract.
[7] Title.
[8] Id., p. 2, par. [0021].
[9] Id., p. 2, pars [0020]and [0021], p. 4, par. [0056], and p. 5, par [0062].

monitoring the remote broadcast of for-demand movie data is carried out as a background function not apparent to the user. Neither Russo nor Blackketter teaches monitoring a remote broadcast of for-demand movie data that can be recorded for playback that is carried out as a background function not apparent to the user.

While Russo allows recording whether or not the user is present, it does not teach recording movies as *a background function not apparent to the user.* Blackketter does not teach any form of recording movies for later playback, so even if combined with Russo, it cannot fill in the deficiencies of the Russo reference.

In the Final Rejection, the Examiner below points to 3 paragraphs of Blackketter, [0021], [0030] and [0038], as support for the assertion that Blackketter teaches the limitation *wherein the steps of monitoring the remote broadcast of for-demand movie data is carried out as a background function not apparent to the user.* But none of these sections teach this limitation. Vauxhall Motors now addresses each, one at a time, to illustrate this point.

First, paragraph [0021] discloses monitoring (1) a "data service channel" for broadcast of "script triggers".[10] Data service channels do not broadcast movies that can be recorded for later playback, thus paragraph [0021] clearly does not teach the limitation *wherein the steps of monitoring the remote broadcast of for-demand movie data is carried out as a background function not apparent to the user.*

Second, paragraph [0030] discloses use of receivers "configured to display Web pages, broadcast television, or both." Here Blackketter teaches that "the Web pages are stored locally on the receivers" but does not make any suggestion regarding broadcast movies recorded for later play back. Thus paragraph [0030] does not teach *wherein the steps of monitoring the remote broadcast of for-demand movie data is carried out as a background function not apparent to the user.*

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[10] Blackketter, par. 21.

Finally, paragraph [0038] states "receiver 407 can tune into two channels simultaneously so that a user can watch a television program on one channel (e.g., baseball game 424) while receiver 407 monitors the second channel for enhancements to business page 434." Blackketter does not teach that the second channel broadcasts are for recording Appellants' claimed for-demand movie data as a background function. Instead Blackketter's background monitoring is of "script triggers" of the type mentioned in paragraph [0021]:

> Business News page might be in information resource associated with a particular business channel or program that periodically broadcasts **script triggers** to news page 434 that provide timely stock prices for a series of companies, each company identified by a symbol.[11]

> Receiver 407 then receives and displays the MSFT stock price upon receipt of **a script trigger** directed to page 434... similarly receiver 408 receives and displays the BA stock price upon receipt of **a script trigger** directed to page 434 and specifying the symbol BA.[12]

Thus there is a second channel being monitored, but it is not a channel that broadcasts for-demand movie data for background recording.

When the Examiner below states "Blackketter teaches that the monitoring of channels can be performed without the user's knowledge...",[13] he is ignoring the claim limitations that require the background monitoring be of for-demand movie data. It is clearly erroneous to ignore this limitation of Vauxhall Motors' claim 3.[14] Thus, even if it were obvious to combine Blackketter with Russo, the combination provides something different from the claimed invention and does not provide the missing claim element.

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[11] Par. [0036]
[12] Par. [0037].
[13] Final Action, p. 4.
[14] "It was a clear error of law for the district court to have ignored the limitations clearly set forth in the claims." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1577, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987), *cert. denied*, 481 U.S. 1052 (1987).

C.   IT IS ERRONEOUS TO COMBINE RUSSO AND BLACKKETTER

The law of the Federal Circuit holds "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so."[14]

Russo is a stored program pay-per-play system.[15] Russo's system has the capability of storing video programming for later playback.[16] Blackketter, on the other hand, is a system for "communicating scripts in a data service channel of a video signal" and simply does not discuss selective recording and playback of video programming or movie data.[17] Russo, which utilizes scheduling information,[18] makes no suggestion of a need for Blackketter's "scripts in a data service channel." And Blackketter itself does not suggest the use of its "scripts in a data service channel" in a pay-for-play system such as Russo. Thus there is no motivation to combine the cited references and any rejection based upon that combination is in error.

SUMMARY

Russo discloses a system for stored program pay-per-play. But it does not disclose a system that can monitor and record movie data as a background function not apparent to the user. Blackketter discloses a system for "communicating scripts in a data service channel of a video signal" but also does not disclose a system that can monitor and record movie data as a background function not apparent to the user. Thus Russo and Blackketter, even when combined, do not disclose the combined requirements of claim 3: (i) *providing a conventional entertainment to the user*, (ii) *monitoring a remote broadcast of for-demand movie data ...(iii) storing the received for-demand movie data; ...and (iv) using the stored for-demand movie data corresponding to the designated entertainment choice to provide*

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[14] *ACS Hospital Systems v. Montefiore Hospital*, 732 F.2d 1572, 221 U.S.P.Q. 929, 933 (1984).
[15] Abstract.
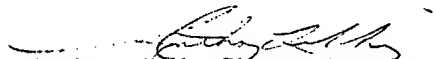[16] Col. 3, lines 9-12 and 47-50.
[17] See, title, p. 1.
[18] See, e.g., Col. 8, line 63 – col. 9, line 19; col. 9, line 48 – col. 10, line 19

entertainment to the user, <u>wherein the steps of monitoring the remote broadcast of for-</u>

<u>demand movie data is carried out as a background function not apparent to the user</u>.

Additionally, the rejection below is based upon a combination of Russo and Blackketter not taught or suggested. For all the foregoing reasons, Vauxhall Motors respectfully requests the Board to **REVERSE** the final rejection of claim 3.

Respectfully submitted,

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CLAIMS APPENDIX

3. An on-demand method of entertaining a user using an entertainment device comprising the steps of:

provinding a conventional entertainment to the user;

monitoring a remote broadcast of for-demand movie data;

receiving the for-demand movie data;

storing the received for-demand movie data;

providing the operator with a selection of choices corresponding to stored for-demand movie data;

receiving a user input designating an entertainment choice representing one of the choices corresponding to stored for-demand movie data;

using the stored for-demand movie data corresponding to the designated entertainment choice to provide entertainment to the user, wherein the steps of monitoring the remote broadcast of for-demand movie data is carried out as a background function not apparent to the user.